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09/580,221

05/26/2000

Sung-Soo Lee

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05/20/2005

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WASHINGTON, DC 20005-1202

EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/580,221

Applicant(s)

LEE, SUNG-SOO

Examiner

CHAN S. PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 11/24/04, and has been entered and made of record. Currently, **claims 1-20** are pending.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.
3. The Examiner attached a copy of translation of Japanese Published Unexamined Patent Applicant (A) No. 03-274943 in the current Office action.

### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "selecting of an advance-transmitting function" of claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

The following quotations of 37 § CFR 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

5. Claim 1 recites the limitation "a facsimile receiving part" in line 4. There is insufficient antecedent basis for this limitation in the claim. It should be "said facsimile receiving part".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 18 fails to correspond in scope with that which applicant regard as the invention can be found in page 8 of the original Specification filed 5/26/00. In that paper, applicant has stated “[f]irst, an advance-transmitting function is selected. Then, the telephone number of the receiving part facsimile 200 is input using the number and letter generating unit 172 of the OPE 170 as shown in figs. 2 and 5”, and this statement indicates that the invention is different from what is defined in the claim because the claim recites that the selecting of the advance-transmitting function is performed when said call is connected. Moreover, referring to fig. 4, the Specification seems to indicate that the selection is done before S100. However, the claim defines the selection to be done after S300. For the examining purpose, the examiner interprets the selection to be done before S100 as it is defined in the Specification.

7. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is uncertain as to whether said data output order is displayed again on another operational panel when said data output order is received from facsimile receiving part is already displayed according to the last part of claim 8. Further, it is unclear as to whether “an operational panel” recited in claim 20 is the same operational panel recited in claim 8. Additionally, “further comprised” should be -- further comprising --.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. U.S. Patent No. 6,449,063 (hereinafter Yoshida).

8. With respect to claim 1, Yoshida teaches a method for controlling transmission of fax data according to a data output order of a facsimile receiving part (figs. 5, 6 & 9), the method comprising the steps of:

scanning and storing a document into data to be transmitted from a facsimile transmitting part to said facsimile receiving part (col. 5, lines 15-19);

dialing a predetermined telephone number of said facsimile receiving part when said document is completely scanned (S84 in fig. 5);

requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed (S88); and

transmitting by said facsimile transmitting part, said stored document data according to said received data output order (either both-side transmission or one-side transmission & col. 3, lines 38-48).

9. With respect to claim 5, Yoshida teaches the method of claim 1, with said scanned document data being managed in a unit of a page and being stored in a memory of said facsimile transmitting part (figs. 5, 6 & 9 and col. 9, lines 3-10).

10. With respect to claim 6, Yoshida teaches the method of claim 1, with said requiring of said document order being made during Phase B of a facsimile transmission, Phase B being a sequence of checking states of said facsimile transmitting part and a transmission line and controlling said facsimile transmitting part among a plurality of predetermined protocols used in transmission and reception of facsimile data (col. 7, line 66 – col. 8, line 9 & figs. 12-15).

11. With respect to claim 7, Yoshida teaches the method of claim 1, with said dialing a predetermined telephone number of said facsimile receiving part being automatic (S84 in fig. 5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 1 above, and further in view of Ishizuka et al. U.S. Patent No. 5,282,050 (hereinafter Ishizuka).

12. With respect to claim 2, Yoshida teaches the method of claim 1 but it does not teach expressly the step of displaying said data output order received from said facsimile receiving part, on said facsimile transmitting part.

Ishizuka, the same field of endeavor of the facsimile art, teaches the method of inquiring and receiving the destination device output order function wherein the received information is displayed on the operational panel of the transmitting part (col. 7, lines 36-52).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the displaying method of Ishizuka into the facsimile of Yoshida.

The suggestion/motivation for doing so would have been to notify the user at the transmitting side whether or not the destination device has a dual-side printing function.

Therefore, it would have been obvious to combine Yoshida with Ishizuka to obtain the invention as specified in claim 2.

13. With respect to claim 4, Yoshida teaches the method of claim 1 wherein said facsimile receiving part reporting said data output order to said facsimile transmitting part by sending a predetermined bit of data (figs. 12-15).

Yoshida, however, does not teach expressly that said transmitting part and said receiving part support a non-standard mode.



Ishizuka, the same field of endeavor of the facsimile art, teaches the method of inquiring and receiving the destination device output order function wherein said facsimile transmitting part and said facsimile receiving part support a non-standard mode (col. 7, lines 55-67).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the non standard facsimile method of Ishizuka into the facsimile of Yoshida.

The suggestion/motivation for doing so would have been to provide a non-standard function in the facsimile communication.

Therefore, it would have been obvious to combine Yoshida with Ishizuka to obtain the invention as specified in claim 4.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 1 above, and further in view of Suzuki Japanese publication No. 03-274943. Refer to the submitted translation of the Japanese publication.

14. With respect to claim 3, Yoshida teaches the method of claim 1, but it does not teach expressly that the said data output order is determined by either a face down way or a face up way.

Suzuki, the same field of endeavor of the facsimile transmission based on the output order of the receiving part art, teaches a method of controlling transmission of fax data (figs. 1 & 2) according to a data output order of a facsimile receiving part (receiver 8), the method comprising steps of:

storing a document into data to be transmitted from a facsimile transmitting part (store and forward exchanger 1) to the facsimile receiving part (page 3, lines 12-19);

dialing a predetermined telephone number of said facsimile receiving part when said document is completely stored (page 3, lines 12-19);

requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed (page 3, lines 12-19); and

transmitting by said facsimile transmitting part, said stored document data according to said received data output order, with said data output order being either a face down way or a face up way, said face down way being said stored document data outputted in order from a first page to a last page of said stored document data, said face up way being said stored document data outputted in reversed order from a last page to a first page of said stored document data (page 6, line 16 – page 7, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the requiring and receiving said data output order, wherein said data output order being either a face down way or a face up way, of Suzuki into the facsimile method of requiring and receiving said data output order of Yoshida.

The suggestion/motivation for doing so would have been to eliminate the need of reorganizing the received document pages at the receiver side (page 7 of Suzuki).

Therefore, it would have been obvious to combine Yoshida with Suzuki to obtain the invention as specified in claim 3.

Claims 8, 9, 11, 12 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Ishizuka.

15. With respect to claim 8, Yoshida teaches a method (figs. 5, 6 & 9), comprising the steps of:

scanning a document into data to be transmitted from a facsimile transmitting part to a facsimile receiving part (col. 5, lines 15-19);

storing said data of said document in a memory of said facsimile transmitting part (S72 in fig. 5);

making a call by dialing a predetermined telephone number of said facsimile receiving part when said document is completely scanned and stored in said memory (S84 in fig. 5);

checking whether said call between said facsimile transmitting part and said facsimile receiving part is connected (fig. 12);

requiring a data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected (S88);

receiving said data output order by said facsimile receiving part from said facsimile transmitting part after said requiring of said data output order (S88); and

transmitting said data of said document stored in said memory according to said received data output order (either both-side transmission or one-side transmission & col. 3, lines 38-48).

Yoshida, however, does not teach expressly the step of displaying said data output order received from said facsimile receiving part, on said facsimile transmitting part.

Ishizuka, the same field of endeavor of the facsimile art, teaches the method of inquiring and receiving the destination device output order function wherein the received information is displayed on the operational panel of the transmitting part (col. 7, lines 36-52).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the displaying method of Ishizuka into the facsimile of Yoshida.

The suggestion/motivation for doing so would have been to notify the user at the transmitting side whether or not the destination device has a dual-side printing function.

Therefore, it would have been obvious to combine Yoshida with Ishizuka to obtain the invention as specified in claim 8.

16. With respect to claim 9, Yoshida teaches the method with said dialing the predetermined telephone number being automatically dialed when said document is completely scanned (S84 in fig. 5).

17. With respect to claim 11, arguments analogous to those presented for claim 4, are applicable.

18. With respect to claim 12, Yoshida teaches the method, with said scanned document data being managed in a unit of page (figs. 5, 6 & 9 and col. 9, lines 3-10).

19. With respect to claim 18, Ishizuka teach the method further comprising of selecting an advance-transmitting function to accommodate said requiring said data

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output order by said facsimile transmitting part from said facsimile receiving part when said call is connected (col. 7, lines 33-52 & col. 8, lines 32-41).

20. With respect to claim 19, Ishizuka teaches the method, wherein after the data output order of the facsimile data is displayed on a display of said operational panel, the facsimile data stored in a memory is then transmitted to said facsimile receiving part according to the displayed data output order (col. 8, lines 32-41).

21. With respect to claim 20, Ishizuka teaches the method, further comprised of displaying said data output order when said data output order is received from said facsimile receiving part on a display on an operational panel (col. 7, lines 36-52).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida and Ishizuka as applied to claim 8 above and in further view of Suzuki.

22. With respect to claim 10, arguments analogous to those presented for claim 3, are applicable.

Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Ishizuka and in further in view of Bloomfield U.S. Patent No. 6,693,729.

23. With respect to claim 13, Yoshida discloses a facsimile transmitting part apparatus, comprising:

a scanner of said facsimile transmitting part scanning data of a document and converting the data into digital image data (col. 5, lines 15-19);

a control unit utilizing the digital image data from said scanner, said control unit controlling said facsimile transmitting part according to a system program, said control unit requiring and receiving a document output order from a facsimile receiving part (S88), said document output order being an order of document pages determined by and being printed on said facsimile receiving part (either both-side transmission or one-side transmission & col. 3, lines 38-48);

a memory storing said system program guiding said control unit, the digital image data from the document being stored in said memory before being transmitted to said facsimile part by a transmission signal from said controller (col. 7, lines 1-10); and

a modem through a control of said control unit modulating said digital image data into analog data formatted for transmission over a PSTN (col. 2, lines 42-49).

Yoshida, however, does not disclose expressly an operational panel having a plurality of keys generating key data of said facsimile transmitting part to said control unit, said operational panel having a display unit showing the document output order of said facsimile receiving part.

Ishizuka, the same field of endeavor of the facsimile art, discloses a facsimile apparatus having an operational panel having a plurality of keys generating key data of said facsimile transmitting part to said control unit, said operational panel having a display unit showing the document output order of said facsimile receiving part (col. 7, lines 33-52).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the displaying method of Ishizuka into the facsimile of Yoshida.

The suggestion/motivation for doing so would have been to notify the user at the transmitting side whether or not the destination device has a dual-side printing function.

The combination of Yoshida and Ishizuka, however, does not disclose expressly that the network control unit forms a communication loop of the public telephone network having a ring and a tip.

Bloomfield discloses a facsimile communication system using a communication loop of the public telephone network having a ring and a tip capabilities (col. 4, lines 26-36).

Yoshida, Ishizuka and Bloomfield are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the PTSN having a ring and a tip signal into the facsimile system of Yoshida and Ishizuka to provide a facsimile network having a ring and a tip capabilities.

Therefore, it would have been obvious to combine Yoshida, Ishizuka and Bloomfield to obtain the invention as specified in claim 13.

24. With respect to claim 15, arguments analogous to those presented for claim 4, are applicable.

25. With respect to claim 16, arguments analogous to those presented for claim 5, are applicable.

26. With respect to claim 17, arguments analogous to those presented for claim 6, are applicable.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida, Ishizuka and Bloomfield as applied to claim 13 above and in further view of Suzuki.

27. With respect to claim 10, arguments analogous to those presented for claim 3, are applicable.

### ***Conclusion***

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
May 12, 2005

Chan S. Park  
Examiner  
Art Unit 2622

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER